

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
G. William Ragland) Group Art Unit: 3728
Application No.: Unassigned) Examiner: D. Fidei
Filed: January 9, 2002)
For: MULTICCOMPARTMENT)
STRUCTURE FOR INSULATION)
AND OTHER MATERIALS)

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This application is a continuation of Parent Application No. 09/570,396 and is filed to be copending with the parent application. In that regard, a three month extension of time has been filed in the parent application to extend its pendency to January 9, 2002. A copy of the extension of time is enclosed.

This Preliminary Amendment is filed in this application as a response to the Office Action mailed July 9, 2001, in Parent Application No. 09/570,396. Applicant requests that the following remarks be considered with the initial examination of this application.

This application contains both product and method claims, as did the parent application. The Examiner is requested to examine all claims and withdraw the Restriction Requirement made in the parent application.

In Parent Application No. 09/570,396, Applicant filed an amendment which inserted into the specification at appropriate points text lifted from specific U.S. Patents and U.S. Patent Applications that had been referred to and incorporated by reference in the parent specification as originally filed. The Examiner objected to the inserted text as new matter under 35 U.S.C. §132. In order to provide the Examiner a specification which will be easier to examine, Applicant has elected to refile the application with the present "clean" specification which includes only the original parent application text and text now incorporated from the patents and applications referenced and incorporated by reference in the original parent application.

The Examiner's objection to incorporating Patent No. 6,104,004 by amendment to the parent specification has been noted, and Applicant has determined that the amendment incorporating that patent No. was an error. This patent No. has not been included in the text of the present application, thereby removing any new matter question with respect thereto.

Enclosed with the Information Disclosure Statement submitted herewith is a copy of copending Application No. 09/422,140 for the Examiner's review, which copending application was incorporated by reference at page 7, line 24 in the original parent application. For convenience of the Examiner, it can be noted that the portion of the

specification at page 8, line 12 to page 10, line 11 in the present application is the text copied from the copending Application No. 09/422,140 at page 8, line 17 to page 10, line 18 and inserted in the present application. Since the copending application was specifically incorporated by reference in the parent application, copying text from the copending application and inserting it into the present application cannot be new matter under the provisions of MPEP §2163.07(b) and MPEP §608.01(p), which specifically provide for this procedure and provide that following such procedure will not result in new matter.

Also, it is requested that the Examiner note that, in the parent application at page 3, line 19 and at page 7, line 21 (page 3, line 27 and page 8, line 5 in the present application), Applicant indicated that multilayer metal foil construction was considered especially important. Also, it should be noted that the patent disclosures incorporated by reference in the parent application are mostly directed to multilayer metal foil structures and devices. Therefore, compared to the parent application, the text insertion at pages 8 through 10 and other insertions in the present application with reference to multilayer metal foil construction is not new matter, but is merely an expansion of the original specification as provided by the above referenced MPEP procedure. There has been no change in the invention disclosed in the parent application.

Applicant respectfully requests that the Examiner reconsider the new matter objection in view of the above facts and withdraw the objection.

The Drawings

The drawings were objected to by the Examiner under 37 CFR §1.83(a) for failing to show every feature of the invention specified in the claims. As set forth in the specification on page 7, in the 2nd paragraph, "when metal foil sheets are used, single sheets of appropriate thickness may be used or multiple sheets of desired thickness may be used, for example, to enhance the insulating value of the multicompartiment sheets containing unitized materials." Therefore, to one skilled in the art, the drawings when read in conjunction with the specification, show each and every feature of the invention specified in the claims.

35 U.S.C. §112

In the parent application, the Examiner had rejected Claims 1-5 and 8-13 under 35 U.S.C. §112, 1st paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As set forth in the MPEP §2164.04, in order to make a rejection under the enablement requirement, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. Furthermore, a specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, 1st paragraph, unless there is reason to doubt the

objective truth of the statements contained therein which must be relied on for enabling support.

In this particular application, the Applicant provides more than ample guidance to one skilled in the art regarding how to make and use the claimed invention. The Examiner is requested to note the state of the art of making various multilayer metal foil structures and devices, in part as represented by the patent disclosures incorporated by reference in the parent application specification. One skilled in such art would have no question regarding how to make and use the structures and devices of the parent application following the teachings in the parent application (without, but preferably with, the disclosures incorporated by reference therein). The same is true for the present application, since it is the same subject matter disclosure without any new matter introduced. More specifically, in page 5, 2nd paragraph, the specification states that, "the sheets can be attached or sealed together by adhesive strips, which may be thermoplastic or thermoset adhesive, by welding such as illustrated in U.S. Patent No. 5,524,406, or by interlocking the top and bottom sheets from corrugations in the sheets utilizing the methods disclosed in U.S. Patent No. 5,939,212." In addition, the specification provides guidance in regard to the multilayer metal foil materials by stating that "the multilayer metal foil materials useful in the methods and products of this invention are disclosed in U.S. Patent No. 5,658,634; 5,800,905; and in U.S. Patent Application Serial No. 09/422,140, filed October 20, 1999." As such, the parent application as filed states the reason and/or

purpose for incorporation by reference and provides full guidance to one skilled in the art to make and/or use the inventions claimed therein, as well as in this application.

The Examiner rejected Claims 1-5 and 8-13 under 35 U.S.C. §112, 1st paragraph, on the grounds that the best mode contemplated by the inventor had not been disclosed.

Applicant does not understand how the Examiner could reach any conclusion that the detailed original disclosure provides any evidence that this Applicant did not disclose the best mode. Moreover, it should be apparent to the Examiner and any person skilled in the art that there is no single best mode for carrying out the present invention. There are various best modes for various configurations and various uses of the methods and structures of this invention. The original disclosure directs one skilled in the relevant art to the various configurations and uses and how to implement same. One aspect of the invention preferred by the inventor, which may or may not be a best mode contemplated by the inventor for any particular application of the invention, is the multilayer metal foil aspect of the invention, as referenced at page 3, line 19 and page 8, line 9 in the parent specification.

The Examiner is requested to reconsider and withdraw the rejection related to best mode disclosure.

Claims 1-5 and 8-13 were rejected under 35 U.S.C. §112, 1st paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As set forth above, the application as originally filed disclosed a multicompartiment sheet having a bottom sheet and a top sheet comprising a single sheet or multiple sheets of any desired thickness as referred to in the specification and in the incorporated references. Thus, Applicant's choice to proceed with a multilayered metal foil as originally disclosed, conveys to one skilled in the art, that the Applicant, at the time the application was filed had possession of the claimed invention, particularly the multilayer metal foil aspect of the invention.

Claims 1-5 and 8-13 were rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In view of the original disclosure of the multilayer metal foil aspect of the invention, it is not understood on what basis the Examiner can take the position that the invention was not enabled to one skilled in the art by the parent application disclosure. As set forth, the application as originally filed disclosed a multicompartiment sheet having a bottom sheet and a top sheet comprising a single sheet or multiple layer sheets of desired thickness. Thus, Applicant's choice to claim a multilayered metal foil aspect, as originally disclosed, is sufficient to particularly point out and distinctively claim the subject matter which Applicant regards as the invention. The claims in this application, when read in light of the specification, very distinctly claim the subject matter of this application.

35 U.S.C. §102 and §103

The Examiner is requested to reconsider and withdraw the prior art rejections, because the prior art does not disclose or make obvious the multilayer metal foil structures claimed in this application.

Conclusions

Examination and allowance of the this application are respectfully requested. In the event that there are any questions concerning this Preliminary Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,

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